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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,996

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EXAMINER

VU, THANH T

ART UNIT

PAPER NUMBER

2175

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DELIVERY MODE

11/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,996	Applicant(s) HERPEL ET AL.	
	Examiner THANH T. VU	Art Unit 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/28/2010 has been entered.

This communication is responsive to Amendment, filed 09/28/2010.

Claims 1-16 are pending in this application. In the Amendment, claims 1, 3, and 10 were amended.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1 recites “a first portion of audio-visual data and a first portion of menu data is retrieved”. The phrase, “A first portion of audio-visual data and a first portion of menu data is retrieved” is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 10, 11, 14, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 and 3 recite the limitations "the placeholder" and "said placeholder". There are insufficient antecedent basis for the limitations in the claim.

Claims 1 and 3 recite the phrase "wherein said second portion of audio-visual comprises no menu data and wherein said second portion of menu data comprises audio-visual menu data and has at least one first attribute associated." It is unclear which of the "said second portion of audio-visual" or "said second portion of menu data" has at least one first attributed associated.

Claim 10 recites "may not" and "may be" render the claim indefinite.

Claim 10 recites the limitations "the menu data" on line 3, "the data" on line 10, "the second portion of menu data" on line 12 and "the placeholders" on line 11. There are insufficient antecedent basis for the limitations in the claim.

Claim 10 recites the phrase "an attribute associated with the placeholder and specifying a location on another storage medium where to retrieve the data by which the placeholder may be replace for generating a visible menu button." It is unclear of what "specifying a location on another storage medium."

Claim 11 recites the limitation "the stored second portion of audio-visual data". There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the exchangeable storage medium" and "said medium". There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "selectable buttons another". It is unclear what is meant by "selectable buttons another."

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinallo et al. (US 5,929,857) and Collart et al. ("Collart", Pub. No. 2006/0181965).

Per claim 1, Dinallo teaches a method for automatically composing an electronic audio-visual menu for selection of playback of audio-visual data, wherein a first portion of audio-visual data and a first portion of menu data is retrieved from a first storage medium being an exchangeable pre-recorded medium, and wherein a second portion of audio-visual data and a second portion of menu data are obtained from a second data source different from said first storage medium (fig. 1), wherein said second portion of menu data has at least one attribute associated, the method comprising the steps of:

generating an initial menu from the first portion of menu data, the initial menu containing one or more visible, selectable buttons and at least one invisible placeholder that cannot be selected, wherein the placeholder has at least one attribute associated (col. 9, lines 1-12 and 35-42, col. 10, lines 30-42);

extracting said attribute associated with the second portion of menu data (col. 7, lines 22-25 and lines 53-58; col. 9, lines 1-12);

comparing said extracted attribute with said attribute associated with the placeholder; and based on said comparison, if both attributes match, replacing the placeholder with a visible and

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selectable button defined by the second portion of menu data (col. 7, lines 40-45 and lines 54-60; col. 9, lines 44-51; col. 10, lines 31-42).

Dinallo does not specifically teach “the first portion of menu data comprising audio-visual data” and wherein said second portion of audio-visual comprises no menu data and wherein said second portion of menu data comprises audio-visual menu data.” However, Collart teaches the first portion of menu data comprising audio-visual data and wherein said second portion of audio-visual comprises no menu data and wherein said second portion of menu data comprises audio-visual menu data (figs. 3; [0007]; [0044]; [0049]-[0051].) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Collart in the invention of Dinnallo in order to provide the user with latest video content related a DVD storage medium.

Per claim 2, the modified Dinallo teaches method according to claim 1, further comprising the step of automatically detecting the availability of said second portion of menu data or of said second portion of audio-visual data (Dinallo, col. 7, lines 20-37; col. 10, lines 30-42).

Claim 3 is rejected under the same rationale as claim 1.

Per claim 4, the modified Dinallo teaches method or device according to claim 1, wherein the second data source is a local storage medium, and the data that defines the visible and selectable menu button replacing the placeholder contains a unique reference to the stored second portion of audio-visual data (Dinallo, fig. 1; storage medium 200 and 210).

Per claim 5, the modified Dinallo teaches method or device according to claim 1, wherein the data that defines the visible and selectable button replacing the placeholder further contains

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button location information or a specification of conditions for button activation (Dinallo, col. 8, lines 18-41).

Per claim 6, the modified Dinallo teaches method or device according to claim 1, wherein the data that defines the visible and selectable button replacing the placeholder further contains picture data defining the appearance of the button (Dinallo, col. 9, lines 40-51; col. 10, lines 30-42).

Per claim 7, the modified Dinallo teaches method or device according to claim 1, wherein the exchangeable storage medium is rewritable, and said second portion of audio-visual data and said second portion of menu data are also stored on said medium (Dinallo, fig. 1; storage medium 200 and 210).

Per claim 8, the modified Dinallo teaches method or device according to claim 1, wherein upon replacement of one or more placeholders by one or more visible and selectable buttons another, previously visible and selectable button defined in the first portion of menu data is disabled and switched invisible (Dinallo, col. 8, lines 29-31, lines 55-56; col. 9, lines 1-12 and lines 44-51).

Per claim 9, the modified Dinallo teaches method or device according to claim 1, wherein said second portion of menu data contains navigation chaining information (Dinallo, col. 9, lines 44-52).

Claim 10 is rejected under the same rationale as claim 1.

Per claim 11, the modified Dinallo teaches device according to claim 3, wherein the second data source is a local storage medium, and the data that defines the visible and selectable menu button replacing the placeholder contains a unique reference to the stored second portion

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of audio-visual data (Dinallo, *fig. 2 shows a second data source 210; fig. 5 and col. 60-67; which states of menu buttons*).

Per claim 12, the modified Dinallo teaches device according to claim 3, wherein the data that defines the visible and selectable button replacing the placeholder further contains button location information or a specification of conditions for button activation (Dinallo, *fig. 5 and col. 60-67; which states of menu buttons*).

Per claim 13, the modified Dinallo teaches device according to claim 3, wherein the data that defines the visible and selectable button replacing the placeholder further contains picture data defining the appearance of the button (Dinallo, *fig. 5 and col. 9, lines 1-12 and 60-67 and col. 10, lines 30-35; which shows states of menu buttons having set of bitmaps*).

Per claim 14, the modified Dinallo teaches Device according to claim 3, wherein the exchangeable storage medium is rewritable, and said second portion of audio-visual data and said second portion of menu data are also stored on said medium (Dinallo, *fig. 1 shows exchangeable storage medium 142, 147 and 152; fig. 2 shows audio visual data menu are stored on medium 210*).

Per claim 15, the modified Dinallo teaches device according to claim 3, wherein upon replacement of one or more placeholders by one or more visible and selectable buttons another, previously visible and selectable button defined in the first portion of menu data is disabled and switched invisible (Dinallo, *col. 8, lines 29-31 and lines 50-54, which shows states of buttons and scroll off screen of menu*).

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Per claim 16, the modified Dinallo teaches device according to claim 3, wherein said second portion of menu data contains navigation chaining information (Dinallo, col. 10, lines 44-52).

Response to Arguments

In response to applicant's arguments, the recitation “automatically composing an electronic audio-visual menu for selection of playback of audio-visual data, wherein a first portion of audio-visual data and a first portion of menu data is retrieved from a first storage medium being an exchangeable pre-recorded medium, the first portion of menu data comprising audio-visual data and wherein said second portion of audio-visual comprises no menu data and wherein said second portion of menu data comprises audio-visual menu data and has at least one first attribute associated” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/
Primary Examiner, Art Unit 2175